UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,648	08/02/2006	Hideaki Kiko	AIBARA0003	4356

24203   7590   06/24/2009
GRIFFIN & SZIPL, PC
SUITE PH-1
2300 NINTH STREET, SOUTH
ARLINGTON, VA 22204

EXAMINER
ZHAO, YU

ART UNIT	PAPER NUMBER
2169	

MAIL DATE	DELIVERY MODE
06/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *23 February 2009*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4 and 7-10* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-4 and 7-10* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____.
      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   Acknowledgment is made of applicant's amendment filed on **February 23, 2009**.

Claims 1-4 and 7-10 are presented for examination.

Claims 5 and 6 are cancelled.

Claims 1-4 and 7-10 are amended.

Specification Objections are withdrawn in light of amendment by the applicant.

Claim Objections is withdrawn in light of amendment by the applicant.

35 USC 101 Rejection is maintained, the reasons are set forth below.

Remarks

Applicant requests that, "Applicant respectfully requests that the Examiner check again for the copies of the certified copies of Japanese Patent Application No. 2004-025293, which the USPTO should have received from the International Bureau, and then acknowledge receipt of these documents from the International Bureau."

Examiner has checked again. However, the copies of the certified copies of Japanese Patent Application No. 2004-025293 have not been received.

Response to Argument

2.   Applicant's arguments filed in the amendment filed on **February 23, 2009**, have been fully considered but they are not deemed persuasive:

Applicants argue that, "The Examiner objects to the phrase "a website of the

registered user;" however, the Examiner has taken the phrase out of context. Claim 1,

for example, recites "mounting a virtual tag community on a website of a registered

second user." A person of ordinary skill in the art would understand this phrase to mean

that the website is operated and/or controlled by a registered second user and that a

virtual tag community is mounted on this website. A person of ordinary skill in the art

would realize that the term "mounting" means "loading" (See, e.g., COMPUTER

PROFESSIONAL'S DICTIONARY 232 (1990)). Thus, a person of ordinary skill in the art

would instantly realize that the phrase "mounting a virtual tag community on a website

of a registered second user" means "[loading] a virtual tag community on a website of a

registered second user," which is not indefinite."

The explanation of the applicant for the phrase is clear. However, it is not recited

in the claim language. The Examiner suggests the applicant either adds the explanation

into the claim or rephrase the phrase to "mounting a virtual tag community on a website

where a second user is registered."

Applicants argue that, "The Federal Circuit, with the acquiescence of the

Commissioner of Patents and Trademarks, has ruled that computer programs embodied

in a tangible medium, such as floppy disks, are patentable subject matter under 35

U.S.C. § 101. In re Beauregard, 35 U.S.P.Q.2d 1383 (Fed. Cir. 1995). Therefore,

independent claim 9 is patentable subject matter under 35 U.S.C. § 101 because the

subject matter of claim 9 pertains to a "virtual community providing program, stored on a

computer readable storage medium...wherein the computer readable storage medium is an applications database of a virtual community system."

For all of the above reasons, claim 9 recites patentable subject matter under 35 U.S.C. § 101."

The Examiner respectfully disagrees. Claim 9 recites "A computer readable storage medium." The specification does not clearly define which forms the above medium may take. And the applicant does not state that the "computer readable storage medium" **excludes any media which includes carrier waves, signals, or other forms of energy.** Therefore, such medium may take many forms, including, but not limited to, non-volatile, volatile and transmission media etc... If the computer readable medium may take the form of the transmission signal, this would render the claim not statutory because it's not tangible.

U.S.C. 103 Rejection:

The reasons are listed below.

Priority

3.   Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Priority date of **February 2, 2004** is given. However, the certified copy has not been filed.

Claim Objections

4.   Claims 1-4 and 7-10 are objected because of the following informalities:

Claims 1-4 and 7-10 recite "the first virtual community." it is not clear to the examiner, where or what is "the second virtual community"? Also, the terminology "the first virtual community" is not disclosed in the Specification.

Appropriate clarification is required.

Claims 1, 7, 8 and 9 recite "a portion of the first virtual community" it is not clear and broad (e.g. What or which portion?) Also, the terminology "a portion of the first virtual community" is not disclosed in the Specification.

Appropriate clarification is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

a. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5.   **Claim 9 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.**

Claim 9 recites "A computer readable <u>storage</u> medium", the specification does not clearly define which forms the above medium may take. Such a medium may take many forms, including, but not limited to, non-volatile, volatile and transmission media etc... If the computer readable medium take the form of the transmission signal, this would render the claim not statutory because it's not tangible.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6.   **Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Matsuda (U.S. Pub. No.: US 2002/0054094 A1), in view of Parry

(U.S. Pub. No.: U.S. 2002/0178186).

For claim 1, Matsuda discloses a community providing server providing a

virtual community for a user who has a user terminal connected to the server via

a network, the server comprising:

a user management information database for storing information

concerning registered users who are registered with the virtual community,

wherein the stored information includes addresses of the registered users in the

first virtual community (Matsuda: page 5, paragraph [0048], "Information on the

user registered in the service is stored in the user information

DB 21. During registration in the service, the attributes of

each user, such as the user ID, full name, age, **address,**

electronic mail address, types of hobbies, keywords relating to

that user (such as hobbies) are first of all stored in the user

information DB 21…");

a contents database for storing contents data constituting the virtual

community (Matsuda: page 4, paragraph [0042], page 5, paragraph [0049],

"Information on the community is stored in the community

information DB 22. Information such as the community name,

object of the community's interest…", page 6, paragraph [0059], "The ROM

54 stores programs (for example, the programs described later

on, to run processing for providing services such as electronic

bulletin board [BBS] and mailing lists provided to the community

members, programs to perform new user registration processing,

new community registration processing…").

However, Matsuda does not explicitly disclose a control means for issuing,

for the purpose of mounting a virtual tag community on a website of the

registered user, a community tag that is to be inserted in HTML data constituting

the website, wherein the virtual tag community mounted on the website is only a

portion of the first virtual community corresponding to the address of a third user

who owns the website mounting the virtual tag community.

Parry discloses a control means for issuing, for the purpose of mounting a

virtual tag community on a website of the registered user, a community tag that is

to be inserted in HTML data constituting the website, wherein the virtual tag

community mounted on the website is only a portion of the first virtual

community corresponding to the address of a third user who owns the website

mounting the virtual tag community (Parry: page 2, paragraph [0024], "Customers

may incorporate site search capability into any Web page by

simply copying and pasting HyperText Markup Language (HTML) code

into the Web page.", **paragraph [0025]**, "...combination of novel

JavaScript technology with Uniform Resource Locator (URL)

munging allows a hosted service, such as a hosted site search

engine, to be easily and seamlessly integrated into a customer's

Web site. In this embodiment, static JavaScript code is inserted

into the customer's Web page. This code executes a second

JavaScript program that passes a "munged" URL to the ASP's

servers. The ASP's servers then parse the session variables that

were encoded in the munged URL. Finally, the ASP's servers

generate a dynamic JavaScript program that displays the hosted

service (e.g., a search form) directly within the customer's Web

page. As a result, the Web user is unable to discern that the

services provided using this technique are hosted remotely.", **page**

4, paragraph [0057], "6. Customer server 320 responds to the request

in step 5. Customer server 320 need <u>only recognize the static</u>

<u>portion of the URL</u> and need not process the data that was

munged. Customer server 320 may then <u>respond to the request in</u>

<u>step 5 by transmitting a Web page to user 310</u>. The Web page may

have an instruction embedded within its source code that

instructs user browser 310 <u>to import a service resource</u> from ASP

server 330. For example, this instruction may be an HTML script

`tag that instructs user browser 310 to import, for example, a`

`JavaScript source file from ASP server 330.`", page 8, paragraph [0100]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "`Information processing apparatus,`

`information processing method, service providing system, and`

`computer program thereof`" as taught by Matsuda by implementing "`Remote URL`

`munging business method`" as taught by Parry, because it would provide Matsuda's method with the enhanced capability of "`…a significant advantage over other`

`known installation procedures, some of which require up to`

`sixteen hours.`" (Parry: page 2, paragraph [0024]) and "`…allows a hosted`

`service, such as a hosted site search engine, to be easily and`

`seamlessly integrated into a customer's Web site.`" (Parry: page 2, paragraph [0025]).

For claim 2, Matsuda and Parry disclose the modified community providing server as defined in claim 1, wherein,

the user management information database stores information concerning an avatar that is a character acting for each user in the virtual tag community (Matsuda: page 1, paragraph [0003], page 4, paragraph [0044], page 6, paragraph [0063])**, and**

the control means performs control to show the avatar acting for a <u>fourth</u> user in the virtual tag community (Matsuda: page 4, paragraph [0044]) **who is accessing the website <u>mounting</u> the virtual tag community <u>of</u> the <u>first</u> virtual**

community (Parry: page 2, paragraph [0025], paragraph [0032], page 8, paragraph

[0100]).

Claim 7 is rejected as substantially similar as claim 1, for the similar reasons.

For claim 8, Matsuda discloses a virtual community providing method for

providing a <u>first</u> virtual community for a <u>first</u> user who has a user terminal

connected to a community providing server via a network, the method

comprising <u>the steps of</u>:

<u>(a)</u> issuing a community tag, by the community providing server, for a

<u>second</u> user who accesses the community providing server and registers with

the virtual community (Matsuda: page 4, paragraphs [0042]-[0043], page 5, paragraph

[0048])**<u>, wherein the virtual tag community mounted on the website is only a</u>**

<u>portion of the first virtual community corresponding to the address of a third user</u>

<u>who owns the website mounting the virtual tag community</u> (Parry: page 2,

paragraph [0024], "Customers may incorporate site search capability

into any Web page by simply copying and pasting HyperText Markup

Language (HTML) code into the Web page.", paragraph [0025],

"…combination of novel JavaScript technology with Uniform

Resource Locator (URL) munging allows a hosted service, such as

a hosted site search engine, to be easily and seamlessly

integrated into a customer's Web site. In this embodiment,

static JavaScript code is inserted into the customer's Web page.

This code executes a second JavaScript program that passes a

"munged" URL to the ASP's servers. The ASP's servers then parse

the session variables that were encoded in the munged URL.

Finally, the ASP's servers generate a dynamic JavaScript program

that displays the hosted service (e.g., a search form) directly

within the customer's Web page. As a result, the Web user is

unable to discern that the services provided using this

technique are hosted remotely.", page 4, paragraph [0057], "6. Customer

server 320 responds to the request in step 5. Customer server

320 need only recognize the static portion of the URL and need

not process the data that was munged. Customer server 320 may

then respond to the request in step 5 by transmitting a Web page

to user 310. The Web page may have an instruction embedded

within its source code that instructs user browser 310 to import

a service resource from ASP server 330. For example, this

instruction may be an HTML script tag that instructs user

browser 310 to import, for example, a JavaScript source file

from ASP server 330.", page 8, paragraph [0100]);

(b) sending data of contents of the first virtual community, by the

community providing server, to the user terminal after analyzing the virtual

community tag (Matsuda: page 4, paragraphs [0042]-[0043], [0047]).

However, Matsuda does not explicitly disclose mount a virtual tag community on a website of a registered <u>third</u> user and that accesses the website of the registered <u>third</u> user.

Parry discloses disclose mount a virtual tag community on a website of a registered <u>third</u> user and that accesses the website of the registered <u>third</u> user. (Parry: page 2, paragraph [0024], page 8, paragraph [0100]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon "`Information processing apparatus, information processing method, service providing system, and computer program thereof`" as taught by Matsuda by implementing "`Remote URL munging business method`" as taught by Parry, because it would provide Matsuda's method with the enhanced capability of "…`a significant advantage over other known installation procedures, some of which require up to sixteen hours.`" (Parry: page 2, paragraph [0024]) and "…`allows a hosted service, such as a hosted site search engine, to be easily and seamlessly integrated into a customer's Web site.`" (Parry: page 2, paragraph [0025]).

Claim 9 is rejected as substantially similar as claim 8, for the similar reasons.

Claim 10 is rejected as substantially similar as claim 2, for the similar reasons.

7.   **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuda (U.S. Pub. No.: US 2002/0054094 A1), in view of Parry (U.S. Pub. No.:**

U.S. 2002/0178186) as applied to claim 1 above, and further in view of DuVal (U.S.

Patent No.: U.S. 5,818,836).

      For claim 3, Matsuda and Parry disclose the modified community providing

server as defined in claim 2, wherein, when a <u>fifth</u> user who has not logged into

the <u>first</u> virtual community accesses the website <u>mounting</u> the virtual tag

community, the <u>fifth</u> user is not in a logged-in state in the virtual tag community

(Matsuda: page 4, paragraphs [0046], [0047], page 6, paragraphs [0063]-[0067]).

      However, Matsuda and Parry do not explicitly disclose the control means

performs control to show a specific character.

      DuVal discloses the control means performs control to show a specific

character (DuVal: column 9, lines 4-7, "...includes an icon 108 for

initiating an anonymous voice call").

      It would have been obvious to one of ordinary skill in the art at the time the

invention was made to improve upon "Information processing apparatus,

information processing method, service providing system, and

computer program thereof" as taught by Matsuda by implementing "Method and

apparatus for anonymous voice communication using an online data

service" as taught by DuVal, because it would provide Matsuda's modified method

with the enhanced capability of notifying the user the status of other users.

8.   **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

Matsuda (U.S. Pub. No.: US 2002/0054094 A1), in view of Parry (U.S. Pub. No.:

U.S. 2002/0178186) as applied to claim 1 above, and further in view of Olivier (U.S.

Patent No.: US 6,480,885 B1).

For claim 4, Matsuda and Parry disclose the modified community providing

server as defined in claim 1, wherein,

the user management information database stores an address of the

website of <u>the third</u> user <u>owning</u> the website <u>mounting</u> the virtual tag community

among the registered users, and the control means provides information of the

address of the website for a <u>fourth</u> user via the virtual tag community (Olivier:

column 14, lines 29-33, "This may include email addresses, geographical

data such as a graphical map indicating locations of other

users.").

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to improve upon "Information processing apparatus,

information processing method, service providing system, and

computer program thereof" as taught by Matsuda by implementing

"Dynamically matching users for group communications based on a

threshold degree of matching of sender and recipient

predetermined acceptance criteria" as taught by Olivier, because it would

provide Matsuda's modified method with the enhanced capability of "give the

subscribing user feedback at subscription time on the identities

and/or other info about what subscribers he has been matched up

with" (Olivier: column 14, lines 26-29).

Conclusion

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded

of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to YU ZHAO whose telephone number is (571)270-3427.

The examiner can normally be reached on Monday-Friday 7:30am-5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mahmoudi, Tony can be reached on (571) 272-4078. The fax phone

number for the organization where this application or proceeding is assigned is 571-

270-4427.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date: 6/19/2009

/Yu Zhao/

Examiner, Art Unit 2169

/Yicun Wu/
Primary Examiner, Art Unit 2158